

REMARKS

I. INTRODUCTION

Claims 83 and 103 have been amended but not for any reason relating to patentability thereof. New claims 137-141 have been added. Accordingly, claims 68-141 are now under consideration in the above-referenced application. Provided above, please find a claim listing indicating the amendments of claims 83 and 103 and the addition of new claims 137-141 on separate sheets so as to comply with the requirements set forth in 37 C.F.R. § 1.121. It is respectfully submitted that no new matter has been added.

III. REJECTIONS UNDER 35 U.S.C. §§ 102(b) AND 103(a) SHOULD BE WITHDRAWN

Claims 68-73, 75, 79-82, 86 and 87 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,141,362 issued to Wuster (the "Wuster Patent"). Claims 74, 76-78, 84, 85, 89-102, 104-107, 109-116, 118-128 and 130 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Wuster Patent, in view of U.S. Patent No. 4,607,622 issued to Fritch et al. (the "Fritch Patent"). Claims 83, 88, 103, 108, 117, 129 and 131-136 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over unpatentable over the Wuster Patent in view of the Fritch Patent, and in further view of U.S. Patent No. 3,941,121 issued to Olinger et al. (the "Olinger Patent"). Applicants respectfully assert that the Wuster Patent, taken alone or in combination with the Fritch Patent and/or the Olinger Patent, fails to teach, suggest or disclose the subject matter recited in independent claims 68, 89, 113, 125 and 131, and the claims which depend therefrom.

In order for a claim to be rejected as anticipated under 35 U.S.C. § 102, each and every element as set forth in the claim must be found, either expressly or inherently

described, in a single prior art reference. Manual of Patent Examining Procedures, §2131; also see *Lindeman Maschinenfabrik v. Am Hoist and Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

Under 35 U.S.C. § 103(a), a person is not entitled to a patent even though the invention is not identically disclosed or described as set forth in §102, “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a).

The objective standard for determining obviousness under 35 U.S.C. § 103, as set forth in *Graham v. John Deere, Co.*, 383 U.S. 1 (1966), requires a factual determination to ascertain: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; and (3) the differences between the claimed subject matter and the prior art. Based on these factual inquiries, it must then be determined, as a matter of law, whether or not the claimed subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the alleged invention was made. *Graham*, 383 U.S. at 17. Courts have held that there must be some suggestion, motivation or teaching of the desirability of making the combination claimed by the applicant (the “TSM test”). See *In re Beattie*, 974 F.2d 1309, 1311-12 (Fed. Cir. 1992). This suggestion or motivation may be derived from the prior art itself, including references or disclosures that are known to be of special interest or importance in the field, or from the nature of the problem to be solved. *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996).

Although the Supreme Court criticized the Federal Circuit’s application of the TSM test, see *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, (2007) the

Court also indicated that the TSM test is not inconsistent with the *Graham* analysis recited in the *Graham v. John Deere* decision. *Id.*; see *In re Translogic Technology, Inc.*, No. 2006-1192, 2007 U.S. App. LEXIS 23969, *21 (October 12, 2007). Further, the Court underscored that “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR*, 127 S. Ct. at 1741. Under the precedent established in *KSR*, however, the presence or absence of a teaching, suggestion, or motivation to make the claimed invention is merely one factor that may be weighed during the obviousness determination. *Id.* Accordingly, the TSM test should be applied from the perspective of a person of ordinary skill in the art and not the patentee, but that person is creative and not an automaton, constrained by a rigid framework. *Id.* at 1742. However, “the reference[s] must be viewed without the benefit of hindsight afforded to the disclosure.” *In re Paulsen*, 30 F.3d 1475, 1482 (Fed. Cir. 1994).

The prior art cited in an obviousness determination should create a reasonable expectation, but not an absolute prediction, of success in producing the claimed invention. *In re O’Farrell*, 853 F.2d. 894, 903-04 (Fed. Cir. 1988). Both the suggestion and the expectation of success must be in the prior art, not in applicant’s disclosure. *Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200, 1207 (Fed. Cir. 1991) (citing *In re Dow Chem. Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988)). Further, the implicit and inherent teachings of a prior art reference may be considered under a Section 103 analysis. See *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995).

Secondary considerations such as commercial success, long-felt but unsolved needs, failure of others, and unexpected results, if present, can also be

considered. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-39 (Fed. Cir. 1983). Although these factors can be considered, they do not control the obviousness conclusion. *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 768 (Fed. Cir. 1988).

The Wuster Patent relates to an endoscope equipped both with an observation optic and a Laser beam, including a deflectable reflector enabling the laser beam to scan the body tissue and a focus enabling the laser beam focal plane to be varied depth-wise in the body tissue. (See Wuster Patent, Abstract). The endoscope includes a shaft which accommodates, besides an observation optic 3, a longitudinally extending tube 19 in a parallel channel. The focusable Laser beam is admitted in this tube through the aperture of a stud 20 and a prism 21 in the longitudinal direction, and at the distal end it impinges on a deflection reflector 1 which allows the Laser beam to scan on the object side an area of the tissue being treated within the viewing field of the observation optic. (See *id.*, col. 3, Ins. 8-19; and Fig. 4).

The Fritch Patent relates to an ocular endoscope having a minimum cross-section and designed primarily for use in treating, diagnosing and investigating problems associated with the eye. The endoscope includes a probe which comprises a first bundle of fiber optics carrying light for illumination, a second coaxial bundle of fiber optics terminating in a lens and adapted to view areas being illuminated completely surrounded by a plastic sheath that is semi-rigid and malleable and capable of assuming and holding a preferred shape. (See Fritch Patent, Abstract).

The Olinger Patent relates to a needle endoscope includes a hollow needle of about 18-gauge, a lens system within the needle, an image transmitting bundle of flexible fiber-optic rods within the needle, a plurality of illumination transmitting fiber-optic rods

within the needle, an operative channel within the needle, and apparatus to shift the image transmitting bundle with respect to the lens system and needle to provide focus adjustment for focusing the endoscope on objects at various distances from the end of the needle. (See Olinger Patent, Abstract).

Applicants' invention, as recited in independent claim 68, relates to an apparatus for obtaining information for a structure which comprises, *inter alia*:

a lens arrangement which is configured to provide there through electro-magnetic radiation; and

a dispersive arrangement configured to receive at least one portion of the electro-magnetic radiation and forward a dispersed radiation thereof to at least one section of the structure.

Applicants' invention, as recited in independent claim 89, relates to an apparatus for obtaining diagnostic information for a structure and modifying at least one property of at least one portion of the structure which comprises, *inter alia*:

a plurality of fibers each of which is configured to provide there through the electro-magnetic radiation, at least one first fiber of the fibers being configured to provide a first electro-magnetic radiation to the at least one portion so as to obtain the information, and at least one second fiber of the fibers configured to provide a second electro-magnetic radiation to the at least one portion so as to modify the at least one property; and

a dispersive arrangement configured to receive the first and second electromagnetic radiations.

Applicants' invention, as recited in independent claim 113, relates to an apparatus for obtaining information for a structure which comprises, *inter alia*:

a dispersive arrangement configured to receive a plurality of electro-magnetic radiations and forward a dispersed radiation of each of the electro-magnetic radiations to at least one portion of the structure and at least partially overlap the at least one portion

Applicants' invention, as recited in independent claim 125, relates to an apparatus for obtaining information for a structure which comprises, *inter alia*:

a dispersive arrangement configured to receive at least one portion of an electro-magnetic radiation and forward a dispersed radiation thereof to a particular location on at least one portion of the structure

Applicants' invention, as recited in independent claim 131, relates to an apparatus for obtaining information for a structure which comprises, *inter alia*:

a lens arrangement which is configured to provide there through electro-magnetic radiation; and

a dispersive arrangement configured to receive at least one portion of the electro-magnetic radiation and forward a dispersed radiation thereof to at least one portion

Thus, each of independent claims 68, 89, 113, 125 and 131 recites a "dispersive arrangement." Applicants respectfully assert that Wuster Patent in no way teaches or suggest, much less discloses an apparatus for obtaining information for a structure which includes **a dispersive arrangement that is configured to receive at least one portion (or a plurality) of the electro-magnetic radiation(s)**, as explicitly recited in independent claims 68, 89, 113, 125 and 131 of the above-identified application. In the latest Office Action, the Examiner points to a prism 21 of the Wuster Patent being used within the endoscopic arrangement. (See Office Action dated October 9, 2007, p. 2, Ins. 17-18). Accordingly, it appears that the Examiner is equating the prism 21 of the Wuster Patent to the dispersive arrangement as recited in independent claims 68, 89, 113, 125 and 131.

However, the prism 21 shown and described in the Wuster Patent is a non-dispersive prism. Indeed, the beams propagated in the arrangements of the Wuster Patent

and are also forwarded to the deflection mirror 1 as shown therein are mono-chromatic beams. (See Wuster Patent, Figs. 1a-1c and 2). The prism 21 as shown in Fig. 4 of the Wuster Patent is used to deflect such mono-chromatic beam. As a result, to perform such deflection, this prism 21 is should be a *non-dispersive prism*. Accordingly, it is respectfully asserted that the Wuster Patent fails to teach, suggest or disclose **the apparatus which comprises a dispersive arrangement**, as recited in independent claims 68, 89, 113, 125 and 131 of the above-identified application.

The Fritch and Olinger Patents do not cure such deficiencies of the Wuster Patent, and the Examiner does not contend that they do.

Accordingly, Applicants respectfully submit that the Wuster Patent, taken alone or in combination with the Fritch Patent and/or the Olinger Patent, does not render obvious the subject matter recited in independent claim 68, 89, 113, 125 and 131. The claims which depend from such independent claims are also not taught, suggested or disclosed by the Wuster Patent, taken alone or in combination with the Fritch Patent and/or the Olinger Patent for at least the same reasons.

In addition, with respect to claims 76-78 and 96-98, these claims recite **a two-dimensional image or a three-dimensional image associated with the information for the structure contains a certain amount of resolvable points** (e.g., from about 300,000 to 1,000,000 resolvable points as provided in claims 76 and 96, from about 150,000 to 300,000 resolvable points as provided in claims 77 and 97, and from about 100,000 to 150,000 resolvable points as provided in claims 78 and 98). In the latest Office Action, the Examiner rejects claims 76-78 and 96-98 as being obvious over the Wuster Patent, in view of the Fritch Patent. However, the Fritch Patent fails to even mention, or even teach or

suggest the amount of resolvable points, much less the specific range of the resolvable points as recited in claims 76-78 and 96-98.

Regarding claims 83 and 103, these claims depend from independent claims 68 and 89, respectively, and further include the recitation of **a fluid displacement arrangement cooperative with the dispersive arrangement**. The Examiner appears to be attempting to combine the Olinger Patent with the alleged combination of the Wuster and Fritch Patents to allegedly teach or suggest such subject matter. However, even if, *arguendo*, the Olinger Patent describes a needle which is part of or includes a fluid displacement arrangement, the Olinger Patent fails to cure the deficiencies of the Wuster Patent and the Fritch Patent to teach or suggest that any such fluid displacement arrangement cooperates with the dispersive arrangement. No such cooperation is even mentioned, much less taught or suggested in the Olinger Patent, and the Examiner does not contend that it does.

Concerning claim 85, this claim depends from independent claim 68 and claim 84, and further recites that **first and second fibers providing the electro-magnetic radiation there-through are polished at different angles from one another**. While, the Fritch Patent describes the use of fibers, this publication does not even mention any polishing thereof, much less at angles different from one another.

Thus, for at least these reasons, withdrawal of the rejections of these claims under 35 U.S.C. §§ 102(b) and 103(a) is respectfully requested.

III. NEW CLAIMS 137-141

New claims 137-141 are provided to cover certain exemplary embodiments of the present application. Support for these claims can be found in the originally-filed specification and drawings. Claims 137-141 depend from independent claims 68, 89, 113, 125 and 131, respectively. These claims are believed to be unanticipated and not rendered obvious by the Wuster Patent, taken alone or in combination with the Fritch Patent and/or the Olinger Patent for at least the same reasons as presented herein above. Applicants respectfully request that the Examiner provide a confirmation that new claims 137-141 meet the requirements for patentability in the next communication.

IV. CONCLUSION

In light of the foregoing, Applicants respectfully submit that all pending claims 68-141 are in condition for allowance. Prompt consideration, reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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